



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,429	10/09/2001	Edward T. Grochowski	042390.P4899C	8920

7590 06/27/2005

David J. Kaplan
BLAKELY, SOFOLOFF, TAYLOR & ZAFMAN
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

EXAMINER

LI, AIMEE J

ART UNIT PAPER NUMBER

2183

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/973,429

Applicant(s)

GROCHOWSKI ET AL.

Examiner

Aimee J. Li

Art Unit

2183

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-32, 34-42 and 44-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-32, 34-42 and 44-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>24 March 2005</u> . | 6) <input type="checkbox"/> Other: _____ |

20

DETAILED ACTION

1. Claims 29-32, 34-42, and 44-50 have been considered. Claims 29, 35, 39, and 45 have been amended as per Applicant's request.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims of patent number 6,367,004 contain every element of claims 29-32, 39-42, and 44-50 of the instant application and as such anticipate claims 29-32, 39-42, and 44-50 of the instant application. See *In re Goodman* (CA FC 29 USPQ2d 2010 (12/3/1993)). Regarding the differences in the claims, the limitation of the patent with the "plurality of least significant bits (LSBs)" anticipates "a subset of bits" in the instant application. Also, the PPV value of the patent would not function properly if it were not a Boolean value of TRUE or FALSE.

4. Claim 34 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 in view of claim 7 of U.S. Patent No. 6,367,004. Claim 2 teaches every limitation found in claim 34 of the instant application except "wherein conditionally executing the predicated instruction includes treating the predicated instruction like a no-op if the value of the PPV is FALSE." Claim 7 teaches "wherein conditionally executing

Art Unit: 2183

the predicated instruction includes treating the predicated instruction like a no-op if the value of the PPV is FALSE.” A person of ordinary skill in the art at the time the invention was made would have recognized that the treating a false PPV like a no-op ensures that the PPV does not effect the current instruction sequence, thereby ensuring that the instruction sequence executing is correct. Therefore, it would have been obvious to incorporate the limitation of claim 7 with the limitations of claim 2.

5. Claims 35-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-16 in view of claim 17 of U.S. Patent No. 6,367,004. Claim 13 teaches every limitation of claim 35 of the instant application except “the PPV calculator to calculate a PPV by comparing a subset of bits from a first operand to a subset of bits from a second operand”. Claim 17 teaches “the PPV calculator to calculate a PPV by comparing a subset of bits from a first operand to a subset of bits from a second operand”. A person of ordinary skill in the art at the time the invention was made would have recognized that comparing the subset of bits improves the likelihood that the prediction is correct. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the comparison of subset bits of claim 17 in claim 13 to improve the likelihood of a correctly predicted instruction. Dependent claims 36-38 of the instant application are rejected over claims 14-16 of the patent.

Response to Arguments

6. Applicant's arguments with respect to claims 29-32, 34-42, and 44-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Art Unit: 2183

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aimee J. Li whose telephone number is (571) 272-4169. The examiner can normally be reached on M-T 7:30am-5:00pm.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Chan can be reached on (571) 272-4162. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2183

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AJL
Aimee J. Li
22 June 2005



EDDIE CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100